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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,395	05/03/2001	Marc M. Rehfeld	206748US3	6479

22850 7590 11/21/2002

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EXAMINER
FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
1774	9

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/847,395	REHFELD ET AL.	
	Examiner	Art Unit	
	Lawrence D Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) 9 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-8 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3/8 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed August 30, 2002. rendering Claims 1-9 pending with claim 9 being withdrawn from consideration.

RESPONSE TO REQUEST FOR RECONSIDERATION

2. Applicant's election with traverse of laminated glazing (Group I) is acknowledged. The traversal is on the ground(s) that "the claims of the present invention would appear to be part of an overlapping search area." Applicant further states ' the outstanding restriction requirement on the grounds that a search and examination of the entire application would not place serious burden on the Examiner' is not persuasive. The search of the 2 subclasses would entail the requisite serious burden as the search for composition is not the same as the article search.

The requirement is deemed proper and is therefore made **FINAL**.

Claim Rejections – 35 USC § 102(b)

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Marc Rehfeld (U.S. 5,773,102).

5. Rehfeld discloses a laminated glass pane with good acoustic properties and correct mechanical strength (column 2, lines 32-34) with a 2mm intermediate acoustic film having a bar 9 cm in length and 3 cm in width made with two glass plates of 4 mm thickness having a critical frequency which differs at most by 35% from that of a bar made of the same length (column 2, lines 40-52). Rehfeld discloses the film made of acoustic resin and PVB (column 3, lines 23-25) with the intermediate layer having a thickness (column 5, lines 60-67). Rehfeld discloses critical values corresponding to PVB at a temperature of 20 degrees Celsius (column 5, lines 25-37). Because Rehfeld comprises the same materials having the same function as the instantly claimed invention, it is inherent that the laminated glass pane of Rehfeld has a loss factor and shear modulus. *Something which is old does not become patentable upon the discovery of a new property.* The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent

characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

Patent and Trademark Office can require applicant to prove that prior art products do not necessarily or inherently possess characteristics of his claimed product where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicant where rejection is based on inherency under 35 U.S.C. 102, or on prima facie obviousness under 35 U.S.C. 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection; there is nothing inconsistent in concurrent rejection for obviousness under 35 U.S.C. 103 and for anticipation by inherency under 35 U.S.C. 102.

Claim Rejections – 35 USC § 102(b)

6. Claims 1, 3 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Marc Rehfeld (U.S. 5,368,917).

7. Rehfeld discloses a laminated glazing with a plastic interlayer having properties of acoustic insulation (column 7, lines 40-48) where the glazing has two glass sheets where the interlayer has a thickness (column 7, lines 56-67). Because Rehfeld comprises the same materials having the same function as the instantly claimed invention, it is inherent that the laminated glass pane of Rehfeld has a mechanical

strength, loss factor and shear modulus. *Something which is old does not become patentable upon the discovery of a new property.* The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

Patent and Trademark Office can require applicant to prove that prior art products do not necessarily or inherently possess characteristics of his claimed product where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicant where rejection is based on inherency under 35 U.S.C. 102, or on prima facie obviousness under 35 U.S.C. 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection; there is nothing inconsistent in concurrent rejection for obviousness under 35 U.S.C. 103 and for anticipation by inherency under 35 U.S.C. 102.

Claim Rejections – 35 USC § 102(b)

8. Claims 1, 3 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Marc Rehfeld (U.S. 5,478,615).

9. Rehfeld discloses a laminated glazing with a plastic interlayer having properties of acoustic insulation (column 7, lines 28-35) where the glazing has two glass sheets where the interlayer has a thickness (column 7, lines 45-63) where the glazing has a loss factor (column 4, lines 28-29). Because Rehfeld comprises the same materials having the same function as the instantly claimed invention, it is inherent that the laminated glass pane of Rehfeld has a mechanical strength and shear modulus. *Something which is old does not become patentable upon the discovery of a new property.* The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

Patent and Trademark Office can require applicant to prove that prior art products do not necessarily or inherently possess characteristics of his claimed product where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicant where rejection is based on inherency under 35 U.S.C. 102, or on prima facie obviousness under 35 U.S.C. 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection; there is nothing inconsistent in concurrent rejection for obviousness under 35 U.S.C. 103 and for anticipation by inherency under 35 U.S.C. 102.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

LDF

Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

Cynthia H. Kelly